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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,705	06/30/2000	Shinji Yoshimura	44243P	6865

2292 7590 05/13/2002

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 05/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/21/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6, 9
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, applicant's remarks in his Response (e.g. page 11 middle paragraph) appear to indicate that the presence of several additional elements is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). More particularly, the presence of such limitations as that of claim 2, together with the fact that it is argued that "the substantially flat ring is flexible and is easily deformed and hence a finger can be inserted easily inside this substantially flat ring by deforming the substantially flat ring" appears to define additional critical claim limitations and as such should be incorporated into the independent claim

4. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 51-148383 Patent Abstract. The

reference discloses a wound adhesive tape convenient for carrying and using that ~~it~~ is a nearly flat ring-like core having a predetermined length of adhesive tape wound around the outer peripheral surface of the nearly flat ring-like core, which has a relatively thin thickness and an adhesive surface on the inside of the length of tape. The reference lacks an express teaching that the flat ring body made of a sheet material has the claimed thickness range of claim 1, as well as an express teaching of species which make up the sheet material of claim ²/₇ and the presence of printing on the flat ring body found in applicant's claim 3. However, the thickness range of claim 1 is believed to be, if not inherent, at most an obvious optimization parameter to one of ordinary skill, and the sheet materials of claim 2 are well known in the art. As regards the presence of printing on the substantially flat ring body, this is believed to be at most an obvious parameter to one of ordinary skill in the art, e.g. note JP U 62-129043 as evidence of the state of the art. What additional parameters that may exist are each believed to be, if not either expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

5. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 4-123233 Patent Abstract. This reference discloses a very similar structure to that of JP -383,

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in that it relates to a wound adhesive tape convenient for carrying that is a nearly flat-shaped ring body made of plastic, metal or paper and a predetermined length of tape wound around the outer peripheral surface of the nearly flat-shaped ring-like core, which has a relatively thin thickness, with an adhesive surface inside. The reference again appears to lack a teaching of the flat ring body having a thickness of 10 to 100 microns, as well as the presence of printing found in dependent claim 3. However, these parameters are each treated as set forth in the preceding prior art rejection, and with respect to those parameters that are not either expressly or inherently disclosed, these are again as set forth above believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. The Examiner has withdrawn the prior art rejection based upon Kao et al. in view of applicant's Declaration. With respect to JP -926 Patent Abstract, although applicant argues in his remarks (Response page 10) that the thickness of the ellipse foam core is 0.5 millimeters or more, thereby distinguishing it from the claimed invention, the Examiner notes that this limitation does not appear to be taught in the Examiner's Abstract of the reference. However, the newly relied upon prior art references are each believed to be superior to JP -926, and

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thereby the Examiner has decided to withdraw the prior art rejection of record based upon this reference.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

May 7, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zirker